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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,601	12/31/2003	Timothy L. Hoopman	03001	8504
44977	7590	08/31/2005		
BERGGREN LAW OFFICES, LLC 7090 43RD STREET NORTH OAKDALE, MN 55128			EXAMINER LAYNO, BENJAMIN	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 08/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

TNA

<b>Office Action Summary</b>	<b>Application No.</b> 10/749,601	<b>Applicant(s)</b> HOOPMAN, TIMOTHY L.	
	<b>Examiner</b> Benjamin H. Layno	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Applicant's arguments, see amendment, filed 06/13/05, with respect to the rejection(s) of claim(s) 1-17 under 102 and 103 rejection have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Stauff.

#### ***Claim Rejections - 35 USC § 102 or § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stauff.

The patent to Stauff discloses a pack of playing cards having many of the features recited in claims 1-17. Note, Stauff's first indicia (numerical values) in the primary corners and secondary corners are clearly **horizontally aligned** with the second indicia (suit) in a region bordering the top edge and the bottom edge. In Stauff's playing cards, the judicious placement of the second indicia (suit) in the first position

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being horizontally aligned with the right-reading first indicia in a region bordering the top edge, and the judicious placement of second indicia (suit) in the second position being horizontally aligned with the upside-down reading first indicia in a region bordering the bottom edge, makes Stauff's playing cards **capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known pack of playing cards.

Concerning claim 1, the recitation "a previously known pack of playing cards" is a **relative term** that is open to **broad interpretation**. Any pack of playing cards, e.g. (Uno playing cards, any of the playing cards in the references cited Jannersten, Hofman, Roberts, Nielsen, Raheb, Bommarito, Friedman, etc.) may be called "a previously known pack of playing cards".

In regard to claims, 2 and 9, the Examiner agrees with the Applicant's argument that Stauff's second indicia (suit) in the first position in the region bordering the top edge, and the second indicia (suit) in the second position in the region bordering the bottom edge, are both located at a point **midway** between primary and secondary corners. However, the Examiner takes the position that the term "**horizontally proximate**" is a **relative term** that is open to **broad interpretation**. Thus, Stauff's second indicia (suit) in the first position in the region bordering the top edge, and in the second position in the region bordering the bottom edge, are both located **broadly** horizontally proximate the right-reading first indicia in the region bordering the top edge, and the upside-down-reading first indicia in the region bordering the bottom edge, respectively.

Concerning claims 7 and 11, Stauff's playing cards in Figs. 1 – 9 clearly disclose second indicia (diamond suit), inside the regions bordered by the edges, as being enlarged compared to the second indicia (diamond suit) located outside the region near the primary corners of the playing cards.

The only differences between the claimed invention, and Stauff's playing cards are:

1) In claims 2 and 9, the second indicia (suit) in the first position having a **right-reading orientation** in the region bordering the top edge, the second indicia (suit) in the second position having an **upside-down-reading orientation** in the region bordering the bottom edge. In Stauff's playing cards, the second indicia (suit) reading orientations are reversed, see Figs. 12 – 23.

2) In claims 5 and 16, the second indicia (suit) in the **seventh** position being proximate to and below the right-reading first indicia in the secondary corner in the region bordering the right edge, and the second indicia in the **eight** position being proximate to and above the upside-down-reading first indicia in the secondary corner in the region bordering the left edge. Stauff's playing cards do not have second indicia (suit) in the seventh and eight positions.

3) In claim 8, the picture on the Face Card has an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. The Face Cards in Stauff's playing cards, Figs. 12 – 23 do not have this feature.

These differences only reside in the meaning and information conveyed by **printed matter**. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

Furthermore or in the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stauff's playing cards by positioning the second indicia (suit) in the first position in a right-reading orientation in the top edge, positioning the second indicia (suit) in the second position in an upside-down-reading orientation in the bottom edge, providing second indicia (suit) in the seventh and eighth positions, and replacing the pictures in Stauff's Face Cards with pictures having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. These modifications would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of playing card does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is **no** novel or unobvious functional relationship between the claimed printed matter e.g. (positioning of the first indicia and second indicia, right-reading orientation, upside-down-reading orientation, position of second indicia on

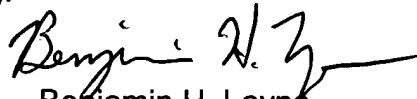
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seventh and eight positions, pictures in Face Cards having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation) and the substrate e.g. (playing card surface) which is required for patentability.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl